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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,065	08/22/2003	James H. Brauker	DEXCOM.012A	9709
20995	7590	10/16/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			SINGH, SATYENDRA K	
2040 MAIN STREET			ART UNIT	PAPER NUMBER
FOURTEENTH FLOOR				
IRVINE, CA 92614			1657	

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/647,065	BRAUKER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Satyendra K. Singh	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 August 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 29-250 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-28 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 August 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/25/05;5/9/05;8/12/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

Applicant's response filed with the office on July 20<sup>th</sup> 2006 is duly acknowledged.

Claims 29-250 (non-elected groups II-IX) are withdrawn from further consideration.

Claims 1-28 (the invention of group I) are examined on their merits in this office action.

### ***Election/Restrictions***

Applicant's election **without traverse** of group I (claims 1-28, and specie "polyester" for claim 20) in the reply filed on July 20<sup>th</sup> 2006 is acknowledged.

### ***Double Patenting***

*The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).*

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,702,857 B2 (same assignee, Dexcom, Inc. San Diego, CA, USA). Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims in US '857 are also drawn to a biointerface membrane for use with an implantable device (such as a glucose sensor) that interferes with the formation of a barrier cell layer formation, including; a first domain that supports tissue attachment and interferes with barrier cell layer formation, and a second domain, which is resistant to cellular attachment and is impermeable to cells and cell processes. In addition, the structural features recited in the instant application (such as interconnected cavities, two domain structure and function, first domain with a solid portion, and structural/functional features of first and second domains, etc.) are nearly identical to the patented claims in US '758. The differences in the structural features of the first domain in the instant application with regards to the fact such as "a substantial number of the interconnected cavities are greater than or equal to about 90 micron in at least one dimension" (see instant claims 1, and 4-16, in particular) would have been obvious to a person of ordinary skill in the art at the time this invention was made, and the fact that need for optimization of such structural features have been known in the art (in order to avoid barrier cell layer formation resulting from inflammatory response such as foreign body response or FBR; see Brauker et al, US 5,741,330, columns 1-2, in particular; IDS submitted by applicant on Jan 25<sup>th</sup> and August 12<sup>th</sup>, 2005), and in order to increase the

*in vivo* life and functionality of the implanted devices (such as continuous monitoring glucose sensors using such biointerface membranes).

Since, the two sets of claims as discussed above, are deemed co-extensive, a non-statutory obviousness-type double patenting rejection is required.

2. Claims 1-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/768,889 (same assignee; Dexcom, Inc. San Diego, CA, USA). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the pending application 10/768,889 are also directed to a biointerface membrane comprising a first domain that comprises a solid portion comprising silicone having plurality of interconnected cavities formed therein; and a second domain which is permeable to the passage of analyte and is impermeable to cells or cell processes. Since, the two sets of claims are deemed co-extensive, a non-statutory obviousness-type double patenting rejection is required.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

As per PPEP 2144.05 (R-3): *In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).*

As per MPEP 2144.05 [R-3], II. OPTIMIZATION OF RANGES - A. Optimization Within Prior Art Conditions or Through Routine Experimentation: *Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. [W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the*

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*optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).*

### ***Conclusion***

NO claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satyendra K. Singh whose telephone number is 571-272-8790. The examiner can normally be reached on 9-5MF (alternate Fridays OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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